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EXAMINER

BOTTS, MICHAEL K

ART UNIT PAPER NUMBER

2176

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,077

Applicant(s)

JONES ET AL.

Examiner

Michael K. Botts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Final Office Action on the merits. This action is responsive to the following communication: Amendment, which was filed on September 13, 2006.
2. Claims 1-24 are currently pending in the case, with claims 1, 12, and 19 being the independent claims.
3. The specification was objected to for inclusion of computer code of excessive length. Applicants have stricken the computer code and attempted to file the code on a compact disc in accordance with 37 CFR 1.96(c). Due to a technical problem in the submission, the code is not sufficiently submitted. However, Applicants have deleted the code from the specification and, Accordingly, the objection to the inclusion of the code in the specification is withdrawn.
4. Claims 1-24 are rejected.

The Specification

5. Applicants are reminded of the requirement to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification, when appropriate, and the status of all citations of U.S. filed applications in the specification should also be updated, when appropriate.
6. It is noted that Applicants attempted in what appears to be good faith to comply with the direction to file specification pages 11-287 on a compact disc in accordance with 37 CFR 1.96(c), however, only one copy of the compact disc was received and

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filed. Applicants are reminded that a computer program listing of more than three hundred lines must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2). Accordingly, applicant is required to file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c).

Information Disclosure Statement

7. Applicants filed a document designated as an Information Disclosure Statement on June 13, 2006. The document files is not in the form of an information disclosure states, and does not provide sufficient information for the Examiner to review and consider the information provided. The document presents factual evidence relating to the patentability of the invention without proper affidavit support. Accordingly, the document is acknowledge as having been received, but has not been considered by the Examiner.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 1-11 specify "computer-readable medium." The disclosure defines "computer readable media" as including but not

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limited to “wireless media such as acoustic, RF, infrared and other wireless media.”

See, disclosure, page 6, lines 15-17. In addition, “computer readable media” is defined as including “communication media,” and “communication media is defined as “typically embodied by computer readable instructions, data structures, program modules, or other data in a modulated data signal, such as a carrier wave or other transport mechanism.” Further, the specification states: “The term ‘modulated data signal’ means a signal that has one or more of its characteristics set or changed in such a manner as to encode information in the signal.” See, disclosure, page 6, lines 10-18. Therefore, the “computer readable medium” specified in claims 1-11 includes carrier waves or other electro-magnetic signals. Absent the specification of signals, claims 1-11 are read as embodying functional descriptive material as functionally related to a computer output.

A signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. See, MPEP, Eighth Edition, Revision 5, section 2106.01.

9. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejection – 35 U.S.C. 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Altova Inc. & Altova GmbH, "XML Spy 4.0 Manual," copyright 1998-2001,

September 10, 2001, downloaded by the Examiner from:

http://www.altova.com/download_archive.html and link, pages 18-286, [hereinafter

"XML Spy"] in view of "TEI, The XML Version of the TEI Guidelines" Text

Encoding Initiative [TEI] Consortium, Copyright 2001, with Introductory Note,

dated March 2002, downloaded by the Examiner from: [http://www.tei-](http://www.tei-c.org.uk/Drafts/P4/driver.xml)

[c.org.uk/Drafts/P4/driver.xml](http://www.tei-c.org.uk/Drafts/P4/driver.xml), on November 25, 2006, downloaded pages 1-93,

[hereinafter "TEI"].

Regarding **independent claim 1**, XML Spy in view of TEI teaches:

*A computer-readable medium having computer-executable components,
comprising:*

*a first component that is arranged to read a word-processor document
stored as an XML file;*

(See, XML Spy, page 207, teaching importation of an XML document.)

a second component that is arranged to use an XSD for interpreting the word-processor document, and

(It is noted that "XSD" was known to one of ordinary skill in the art at the time of the invention consistent with the following definition, which will be the definition used in this Office Action: "Acronym for eXtensible Schema Definition. A prefix used by convention to indicate a W3C schema namespace." Microsoft Computer Dictionary, Microsoft Press, Fifth Edition, 2002. See, XML Spy, page 207, teaching that the XML document is interpreted by an XML schema.)

a third component that is arranged to validate the word-processor document, wherein the validation selectively ignores mixed content within the word-processor document.

(See, XML Spy, pages 176-179, teaching validation, but XML Spy does not expressly teach validation by selectively ignoring mixed content within a word-processor document.

See, TEI, pages 1-3, teaching that the invention is intended to be used for the creation and modification of electronic text documents in XML, which defines a word-processing document. See also, TEI, pages 41-43, teaching that within the body of a DTD, a conditional "ignore" keyword may be used, such that the section marked "ignore" will be selectively not be validated. It is noted that an XML document is validated against the DTD.

XML Spy and TEI are combinable in that they both involve the art of XML document creation and manipulation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of XML Spy and TEI.

The suggestion or motivation for the combination is that TEI adds additional functionality to the validation already taught in XML Spy, resulting in the invention of XML Spy with the additional function in the validation programming to selectively ignore complex content.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of XML Spy and TEI to result in the invention specified in claim 1.)

Regarding **dependent claim 2**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the word-processor document is a template file.

(See, XML Spy, page 125, teaching templates for use with XML documents.)

Regarding **dependent claim 3**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the mixed content comprises text that is not semantically included within an element.

(See, XML Spy, page 187, teaching that annotations may be de-selected from a document.)

Regarding **dependent claim 4**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the mixed content comprises an image that is not semantically included within an element.

(See, XML Spy, page 187, teaching that complex types are de-selectable from the document, which inherently includes an image expressed as a complex type.)

Regarding **dependent claim 5**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, further comprising a formatting component that is arranged to store the word-processor document as an XML file.

(See, XML Spy, page 186, teaching a save function. See also, TEI, pages 1-3, teaching that the invention may be used for maintaining electronic documents, which inherently includes a save function.)

Regarding **dependent claim 6**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 5, wherein the formatting component is further arranged to selectively suppress mixed content within the word-processor document.

(See, XML Spy, pages 269-273, teaching the functions of changing fonts, including setting one font, on the schema, which inherently ignores the mixed content of character attributes. See also, XML Spy, page 187, teaching that complex types are de-selectable from the document.

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See also, TEI, pages 41-43, teaching that within the body of a DTD, a conditional "ignore" keyword may be used, such that the section marked "ignore" will be selectively not be validated.)

Regarding **dependent claim 7**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the third component is further arranged to display errors encountered in validation.

(See, XML Spy, pages 67-72, teaching display of validation errors and re-validation.

See also, XML Spy, page 175, teaching a validation error message specifying the validation error.)

Regarding **dependent claim 8**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, further comprising an editing component that is arranged to received user commands for changing the word-processing document.

(See, XML Spy, teaching editing of XML and non-XML files. See also, TEI, page 2, teaching that the invention may be used for the creation of electronic texts, implicitly including the ability to edit a text document.)

Regarding **dependent claim 9**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the mixed content is selectively ignored in response to a user input.

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(See, XML Spy, pages 269-273, teaching the functions of changing fonts, including setting one font, on the schema, which inherently ignores the mixed content of character attributes. See also, XML Spy, page 187, teaching that complex types are de-selectable from the document.

See also, TEI, pages 41-43, specifically page 41, teaching that a complex content may be ignored globally, individually, or in a preferred order.)

Regarding **dependent claim 10**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the mixed content is selectively ignored in response to environmental variables.

(See, XML Spy, pages 271-273, teaching used of default fonts and coding depending on the originating document type.

See also, TEI, teaching that the ignore keyword may be placed in the DTD such that the mixed content may be ignored in response the environmental variables of the document.)

Regarding **dependent claim 11**, XML Spy in view of TEI teaches:

The computer-readable medium of Claim 1, wherein the mixed content is selectively ignored in response to a declaration in the word-processing document.

(See, XML Spy, page 267, teaching that the text of a word-processing document may be set to XML-text for editing.

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See also, TEI, pages 41-43, teaching that the ignore keyword may be represented by a parameter entity reference such that they are controlled by the declaration in the DTD.)

Regarding **independent claim 12**, XML Spy in view of TEI teaches:

*A method for handling a word-processing document, comprising:
determining whether mixed content within the word-processing document
is to be ignored; and
parsing and validating the word-processing document such that mixed
content does not cause validation errors when the determination has been made
that mixed content within the word-processing document is to be ignored.*

(Claim 12 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.)

Regarding **dependent claim 13**, XML Spy in view of TEI teaches:

*The method of Claim 12, wherein the validating is performed in
accordance with an XSD file.*

(Claim 13 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.)

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Regarding **dependent claim 14**, XML Spy in view of TEI teaches:

The method of Claim 12, further comprising displaying the document according to the instructions contained within the XML file.

(See, XML Spy, page 267, teaching that a document may be opened for editing, displayed, according to the XML instructions.

See, TEI, page 2, teaching that the invention is to be used for preparing documents for display.)

Regarding **dependent claim 15, as amended**, XML Spy in view of TEI teaches:

The method of Claim 12, further comprising storing the document as an XML file.

(Claim 15 incorporates substantially similar subject matter as claimed in claim 5, and is rejected along the same rationale.)

Regarding **dependent claim 16**, XML Spy in view of TEI teaches:

The method of Claim 15, wherein the storing the document further comprises suppressing mixed content when the determination has been made that mixed content within the word-processing document is to be ignored.

(See, XML Spy, pages 186-187, teaching that the document to be save may be set by the user, including ignoring mixed content.

See also, TEI, pages 41-43, teaching use of the ignore keyword for suppressing mixed content.)

Regarding **dependent claim 17**, XML Spy in view of TEI teaches:

The method of Claim 12, wherein the determination is made in response to a user command received in a dialog menu.

(It is noted that the term "dialog menu" does not appear have a set definition. The "dialog menu 1000," identified as Figure 10 in the disclosure is consistent with the term "dialog box" which was well known to one of ordinary skill in the art at the time of the invention, and, accordingly, which will be read as the definition of a "dialog menu" in this Office Action. See, Microsoft Computer Dictionary, Microsoft Press, Fifth Edition, 2002, definition of "dialog box," as follows: "In a graphical user interface, a special window displayed by the system or application to solicit a response from the user." See, XML Spy, pages 186-187, teaching that the document to be save may be set by the user, including ignoring mixed content. See, in particular, the graphical user interface taught on 187, which teaches the graphical user interface disclosed in Figure 10 of the application.)

Regarding **dependent claim 18**, XML Spy in view of TEI teaches:

The method of Claim 12, further comprising displaying errors due to encounter mixed content within the word-processing document when the determination has not been made that mixed content within the word-processing document is to be ignored.

(See, XML Spy, pages 67-72, teaching display of validation errors and re-validation.)

Regarding **independent claim 19, as amended**, XML Spy in view of TEI teaches:

A system for creating, interpreting, and modifying a word-processor document stored as a ML file, comprising:

a ML file;

a validation engine configured to validate the ML file, wherein the validation engine selectively validates mixed content; and

a word processor configured to read the ML file created in accordance with an associated schema.

(Claim 19 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.)

Regarding **dependent claim 20**, XML Spy in view of TEI teaches:

The system of Claim 19, wherein the validation engine selectively validates mixed content in response to user commands received through a system interface.

(Claim 20 incorporates substantially similar subject matter as claimed in claims 17 and 18, and is rejected along the same rationale.)

Regarding **dependent claim 21**, XML Spy in view of TEI teaches:

The system of Claim 19, wherein the word processor is further configured to output the document to a display.

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(See, XML Spy, pages 67-72, teaching display of validation errors and re-validation.

See also, XML Spy, page 175, teaching a validation error message specifying the validation error.)

Regarding **dependent claim 22**, XML Spy in view of TEI teaches:

The system of Claim 19, wherein mixed content within the document is selectively output to the display.

(See, XML Spy, page 267, teaching that a document may be opened for editing, displayed, according to the XML instructions.)

Regarding **dependent claim 23**, XML Spy in view of TEI teaches:

The system of Claim 21, wherein the word processor is further configured to save the validated ML file in a long term memory of the system.

(Claim 23 incorporates substantially similar subject matter as claimed in claim 5, and is rejected along the same rationale. It was obvious and well known to one of ordinary skill in the art at the time of the invention that an XML or "ML" document may be stored to long term memory of a system, such as to a hard drive or to a central server for purposes of long or term retention and later access.

See also, TEI, page 2, teaching that the document may be used for librarians to maintain electronic document, thereby implying long term memory storage.)

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Regarding **dependent claim 24**, XML Spy in view of TEI teaches:

The system of Claim 21, wherein the validation engine is further configured to output validation errors to the display.

(See, XML Spy, pages 67-72, teaching display of validation errors and re-validation.

See also, XML Spy, page 175, teaching a validation error message specifying the validation error.)

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

Applicants' arguments filed September 13, 2006 have been fully considered, but they are not persuasive.

Regarding rejections of claims 1-24:

Applicants argue that the reference, XML Spy, fails to teach or suggest a third component that is arranged to validate the word-processor document, wherein the validation selectively ignores mixed content with the word-processor document." See, Amendment, pages 6-14.

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The Examiner disagrees.

Applicant's argument with respect to claims 1-24 has been considered but is moot in view of the new grounds of rejection. The reference TEI expressly teaches the "ignore" option for validating mixed content, as stated in the rejections above.

Regarding rejections of claim 22:

Applicants argue that the reference, XML Spy, fails to teach or suggest "displaying mixed content." See, Amendment, pages 12-13.

The Examiner disagrees.

Applicant's argument with respect to claim 22 has been considered but is moot in view of the new grounds of rejection. The reference TEI expressly teaches displaying mixed content, as stated in the rejection above.

Regarding rejections of claim 24:

Applicants argue that the reference, XML Spy, fails to teach or suggest "displaying validation errors in validated mixed content."

The Examiner disagrees.

See, XML Spy, page 175, teaching a validation error message specifying the validation error.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb


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